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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,124	02/04/2004	Stephen R. Fahnestock	CL2175USNA	4279

23906 7590 01/05/2006

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EXAMINER

WAX, ROBERT A

ART UNIT PAPER NUMBER

1653

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	Application No. 10/772,124	Applicant(s) FAHNESTOCK ET AL.	
	Examiner Robert A. Wax	Art Unit 1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 5-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08112005</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Introduction***

1. The response filed November 23, 2005 has been received and entered. The prior objection to the specification with regard to the discrepancy between formula 1 and claim 7 is withdrawn since Examiner no longer sees any discrepancy. The previous rejection under 35 USC 103(a) is hereby withdrawn. The rejection under 35 USC 102(b) over Philippe et al. is, however, maintained.

### ***Information Disclosure Statement***

2. The information disclosure statement filed August 11, 2005 has not been considered because the references have already been cited in the previous Office action by the examiner. The references have therefore been lined through on the attached copy of the PTO-1449.

### ***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 2 and 5-22 are again rejected under 35 U.S.C. 102(b) as being clearly anticipated by Philippe et al. (6,280,747).

Philippe et al. teach the claimed cosmetic ingredients in combination with the claimed protein; the sequence recited in instant claim 7 is taught in Figure 6A and the sequence recited in instant claim 8 is taught in Figure 7A. Philippe et al. do not explicitly state that their proteins are water-soluble but since the same monomers are taught in the same number of repeats, the resulting proteins must inherently be water-soluble.

### ***Response to Arguments***

5. Applicant's arguments filed November 23, 2005 have been fully considered but they are not persuasive. Applicants argue that the amendment to recite expression of the silk proteins in microbes, purification at a temperature of less than 20°C and redissolving in water overcomes the anticipation rejection. Applicants further argue that the proteins of the instant invention are "far in excess" in molecular weight of the proteins of Philippe et al.

The first argument is not convincing for two reasons. First, there is no information that the method of making the proteins now recited in the claims affects the structure or solubility of the proteins in any way. It is well established that patentability of a product-by-process claim resides in the product. In the absence of convincing evidence to the contrary, therefore, the proteins of Philippe et al. are the same as the instant proteins. This is further evidenced by the fact that the proteins of Philippe et al.

are disclosed to have a molecular weight from 10-400 kDa (10,000-400,000 Da) as compared to the molecular weight of the claimed proteins of 40,000-500,000 Da.

Clearly, these are comparable ranges.

The other reason the new limitation fails to distinguish over the invention of Philippe et al. is that purification at a temperature of less than 20°C is conventional, as taught by Yang. Yang teaches purification of recombinantly produced spider silk protein at 4°C, which is less than 20°C. A copy of Yang is not being furnished with this Office action since Applicants' attorney already has a copy, sent in the Office action of September 1, 2005 in Serial No. 10/704,337, attorney docket number CL2132 US NA.

For these reasons the above rejection is maintained.

### ***Conclusion***

6. No claim is allowed.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Wax whose telephone number is (571) 272-0623. The examiner can normally be reached on Monday through Friday, between 9:00 AM and 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon P. Weber can be reached on (571) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Robert A. Wax', is positioned above the printed name and title.

Robert A. Wax  
Primary Examiner  
Art Unit 1653

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